

REMARKS

Claims 1 - 4 and 9 - 17 remain active in this application. Claims 5 - 8 have previously been canceled. Amendment of claims 1 and 9 has been requested. Support for the amendments of the claims is found throughout the application, particularly in Figure 1, page 14, lines 1 - 7, and page 27, lines 10 - 15 (indicating that the chip forming the printing head is subjected to dicing and thus indicating that the metal layer does not extend beyond the edges of the chip). No new matter has been introduced into the application.

Claims 1, 2, 4, 9, 10, 12, 16 and 17 have been rejected under 35 U.S.C. §102 as being anticipated by Usui et al., Claims 1, 3, 9, 11 and 13 - 15 have been rejected under 35 U.S.C. §103 as being unpatentable over the admitted prior art in view of Nagahata et al. and claims 2, 4, 10, 12, 16 and 17 have been rejected under 35 U.S.C. §103 as being unpatentable over the admitted prior art in view of Nagahata et al. and Gaynes et al. These rejections are respectfully traversed for the reasons of record and the further remarks provided below and, particularly, as being moot in view of the amendments to independent claims 1 and 9 requested above.

While it appears that the Examiner may be correct in regard to the metal film and sulfur compound film of Usui et al., by the same token, if the sulfur compound is of a molecular thickness on a surface of the metal layer, the thickness of the metal film is substantially irrelevant and thus Usui et al does not teach (or suggest) a metal film "of limited thickness" as recited in the claims as finally rejected. Moreover, it is respectfully submitted that Usui et al. does not teach (or suggest) the internal structure of the print head as recited in the claims as finally rejected, much less

in combination with a metal film, located as claimed. Therefore, no *prima facie* demonstration of anticipation has been made for any claim included in the ground of rejection based on Usui et al. Moreover, the Examiner's reliance on *In re Obiaya* is inapposite since that decision, as applied by the Examiner, involves obviousness rather than anticipation.

However, to fully resolve the issue, amendment of claims 1 and 9 has been requested which specifies the location of the metal film to be "one side of said head body opposite to said orifice plate and said ink ejection units" which is clearly distinct from that disclosed by Usui et al. and from which Usui et al. teaches directly away since the metal film at the claimed location would have no effect on control of the ink meniscus and would prevent Usui et al. from functioning in the manner intended if modified to answer the amendatory recitation. (See, for example, *In re Gordon*, 221 USPQ 1125 (Fed. Circ., 1984)). Therefore, it is abundantly clear that no *prima facie* demonstration of anticipation or obviousness of the claimed subject matter, as amended, can be made.

In regard to the rejections based on the admitted prior art and Nagahata et al. alone or in combination with Gaynes et al., it is respectfully submitted that the admitted prior art cannot supply motivation for inclusion of a metal film for any purpose and it is respectfully submitted that the metal support plate 18 of Nagahata et al. which also functions as a heat sink (both of which functions would be of increased effectiveness with increasing thickness; thus failing to suggest the "limited thickness" claimed) does not supply motivation for the inclusion of a metal film in the print head of the admitted prior art since it does not lead to an expectation of success in avoiding cracking by such inclusion in the particular print head structure of the prior art, particularly where the film

thickness must be limited to effectively perform the function of reinforcing the print head where it is weakened by its internal structure. In short, support is not reinforcement and vice-versa.

Again, to fully resolve the issue and expedite the prosecution of this application, which has become protracted, amendment of claims 1 and 9 has been requested to include the language "extending within a region surrounded by circumferential edges of said substrate, a whole film surface thereof being in contact with an inkjet head frame on which said inkjet recording head is to be mounted" in regard to the location of the metal film and its cooperation with the print head body. This language is distinct from Nagahata et al. since the support plate 18 of Nagahata et al. must be bonded to the print head "only at a longitudinally central portion of the substrate" to prevent imposing forces on the substrate when the support plate is thick enough to function as a heat sink (see column 8, lines 58 - 66) and for which function the support plate 18 exceeds the dimensions of the print head.

Therefore, it is respectfully submitted that the grounds of rejection based on admitted prior art and Nagahata et al. alone or in combination with Gaynes et al. are clearly in error since the combination is improper as being without motivation for the proposed modification and, further, even if the teachings and suggestions of the applied prior art were properly combinable, they do not answer the recitations of the claims, as finally rejected or further amended, and do not provide evidence of a level of ordinary skill in the art which would support the conclusion of obviousness which the Examiner has asserted since they do not lead to an expectation of success in achieving the meritorious effects of the invention, particularly through the subject matter claimed.

In summary, all of the grounds of rejection contained in the present office action are clearly in error and are even more clearly untenable in regard to the claims amended as requested above. No *prima facie* demonstration of anticipation or obviousness has been made in regard to any claim in the application based upon the prior art relied upon or other prior art of record, such as Alderstein, cited but not applied in the present office action. Accordingly, reconsideration and withdrawal of the grounds of rejection of record is respectfully requested.

It is also respectfully submitted that the above-requested amendments should be entered. It is axiomatic that no action should be made final when a *prima facie* demonstration of the propriety of the grounds of rejection contained therein has not been made. Therefore, the finality of the present office action should be withdrawn and the requested amendments entered as a matter of right. In any case, the entry of the requested amendments is well-justified since no significant new issue is raised, particularly in view of the lengthy prosecution of this application, and the requested amendments clearly place the application in condition for allowance. Alternatively, the entry of the requested amendments is well-justified as materially reducing issues and improving form for Appeal. Accordingly, entry of the requested amendments is respectfully requested.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such

action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Marshall M. Curtis".

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